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EXAMINER

ORTIZ, JORGE L

ART UNIT	PAPER NUMBER
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2697

DATE MAILED: 01/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/778,895

Applicant(s)

YAMADA, JIRO

Examiner

Jorge L Ortiz-Criado

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

***Specification***

1. The disclosure is objected to because of the following informalities:

-In page 2, line 22; word "Steam" should be "Stream".

-In page 7, line 10; reference number "231" should be "272".

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

3. Claims 1, 3-5, 7-11, 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Matsumoto et al. U.S. Patent No. 6,320,829.

Regarding claim 1, Matsumoto et al. discloses a multimedia copy control system for controlling a copy of a digital data recording medium in which digital contents data is stored

and from which the digital contents data is reproduced and recorded to another recording medium for copying (See Abstract; Fig. 1),

wherein the digital contents data stored in the digital data recording medium includes a first copy control information of a digital format ( See column 2, lines 42-44)

and a second copy control information of an analog embedded format ( See column 2, lines 46-48), said system comprising:

an encryption decoder adapted to decrypt reproduction output data from the digital data recording medium to judge whether the reproduction output data is encrypted data (See column 8, lines 1-5; (column 8, lines 65-67 to column 9, lines 1-2); Fig. 3);

a first copy control detector adapted to detect the first copy control information from the decrypted reproduction data (See column 9, lines 7-10; Fig. 3, block #28);

a contents data decoder adapted to extract the digital contents data from the decrypted reproduction data (See column 9, lines 18-21; Fig. 3, block #25);

and a second copy control detector adapted to detect the second copy control information from the extracted digital contents data (See column 9, lines 7-10; Fig. 3, block #27),

wherein encryption of the reproduction output data from the recording medium is decrypted and judged for each digital contents unit under reproduction (See Abstract, column 7, line 67 to column 8 lines 1-5),

and in the case where said first copy control detector detects the first copy control information, the reproduction of the digital contents data is controlled based on the first copy control information (See Table on column 11 "Input state and Input Contents"),

and in the case where said first copy control detector detects no first copy control information, the reproduction of the digital contents data is controlled based on the second copy control information (See Table on column 11 “Input state and Input Contents”).

Regarding claim 3, Matsumoto et al. discloses that the recording medium stores the first and second copy control information being allocated in pair for each digital contents unit (See Abstract, column 7, lines 7-16, (column 7, line 67 to column 8 lines 1-5).

Regarding claim 4, Matsumoto et al. discloses analog output control portion adapted to generate analog contents data from the extracted digital contents data (See column 5, lines 25-29; Fig. 3, block #26);

digital output control portion adapted to convert the extracted digital contents data to a specified output format data to be generated therefrom ; wherein the digital contents data outputted via said digital output control portion includes both the first and second copy control information ( See column 9, lines 13-26), (column 10, lines 26- 29, Table on column 11);

and the analog contents data outputted via said analog output control portion includes only the second copy control information (See column 5, lines 25-29; Fig. 3, block #26), (column 10, lines 26- 29, Table on column 11 “Input state, Analog Input”),

Regarding claim 5, Matsumoto et al. discloses a multimedia copy control method for controlling a copy of a digital data recording medium in which digital contents data is stored

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and from which the digital contents data is reproduced and recorded to another recording medium for copying (See Abstract, column 2, lines 25 –62),

wherein the digital contents data stored in the digital data recording medium includes a first copy control information of a digital format ( See column 2, lines 42-44)

and a second copy control information of an analog embedded format( See column 2, lines 46-48) , said method comprising:

decrypting reproduction output data from the digital data recording medium to judge whether the reproduction output data is encrypted data (See column2, lines 52- 55, column 8, lines 1-5; (column 8, lines 65-67 to column 9, lines 1-2); Fig. 3);

detecting the first copy control information from the decrypted reproduction data; extracting the digital contents data from the decrypted reproduction data (See column 2, lines 52-56; column 9, lines 7-10);

and detecting the second copy control information from the extracted digital contents data (See column 2, lines 52-56; column 9, lines 7-10),

wherein encryption of the reproduction output data from the recording medium is decrypted and judged for each digital contents unit under reproduction (See Abstract, column 7, line 67 to column 8 lines 1-5),

and in the case of detecting the first copy control information, the reproduction of the digital contents data is controlled based on the first copy control information (See Table on column 11 “Input state and Input Contents”),

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and in the case of detecting no first copy control information, the reproduction of the digital contents data is controlled based on the second copy control information (See Table on column 11 "Input state and Input Contents"),

Regarding claim 7, Matsumoto et al. discloses an optical disk reproduction device for reproducing an optical disk in which digital contents data is stored and from which the digital contents data is reproduced for copying (See Abstract, column 3, lines 35-36; Fig. 3),

wherein the digital contents data stored in the optical disk includes a first copy control information of a digital format ( See column 2, lines 42-44)

and a second copy control information of an analog embedded format ( See column 2, lines 46-48), said reproduction device comprising:

a stream data extracting unit adapted to extract stream data from the reproduction output data of the optical disk (See Fig. 3, block #21);

an encryption decoder adapted to decrypt the extracted reproduction stream data to judge whether the reproduction stream data is encrypted data (See column 8, lines 1-5; (column 8, lines 65-67 to column 9, lines 1-2); Fig. 3);

a first copy control detector adapted to detect the first copy control information from the decrypted reproduction-stream data (See column 9, lines 7-10; Fig. 3, block #28);;

a contents decoder adapted to extract and decode the digital contents data from the decrypted reproduction stream data (See column 9, lines 18-21; Fig. 3, block #25);

a second copy control detector adapted to detect the second copy control information from the extracted digital contents data (See column 9, lines 7-10; Fig. 3, block #27);

an analog output controller adapted to output analog contents data from the extracted digital contents data (See column 5, lines 25-29; Fig. 3, block #26);;

a digital output controller adapted to convert the extracted digital contents data to a specified output format data to be generated therefrom (See column 9, lines 13-26), (column 10, lines 26- 29, Table on column 11; Fig. 3, block #26);

and a system controller which receives the first and second copy control information and controls said analog output controller and said digital output controller ( See column 9, lines 13-26), (column 10, lines 26- 29, Table on column 11; Fig. 3, block #26);

wherein encryption of the reproduction output data from the optical disk is decrypted and judged for each digital contents unit under reproduction (See Abstract, column 7, line 67 to column 8 lines 1-5),

and in the case where said first copy control detector detects the first copy control information, the reproduction of the digital contents data is controlled based on the first copy control information (See Table on column 11 "Input state and Input Contents"),

and in the case where said first copy control detector detects no first copy control information, the reproduction of the digital contents data is controlled based on the second copy control information (See Table on column 11 "Input state and Input Contents"),

Regarding claim 8, Matsumoto et al. discloses when a reproduction permission condition is not met, said system controller controls said analog output controller and said digital output controller to restrict the reproduction based on at least one of the first and second copy control information (See Table on column 11 "Input state and Input Contents"),



Regarding claim 10, Matsumoto et al. discloses a digital contents data outputted via said digital output control portion includes both the first and second copy control information (See column 9, lines 13-26), (column 10, lines 26- 29, Table on column 11; Fig. 3, block #26);

and the analog contents data outputted via said analog output control portion includes only the second copy control information (See column 5, lines 25-29; Fig. 3, block #26), (column 10, lines 26- 29, Table on column 11 "Input state, Analog Input").

Regarding claim 11, Matsumoto et al. discloses a digital data reproducing and recording system (See Fig. 1)

which is a connection combination of a recording medium reproduction device for reproducing digital data of a recording medium (See Fig. 3)

and a recording medium recording device for recording the reproduced digital data to another recording medium, adapted to control a multimedia copy of the recording medium (See Fig. 4),

wherein the digital contents data stored in the recording medium includes a first copy control information of a digital format (See column 2, lines 42-44)

and a second copy control information of an analog embedded format (See column 2, lines 46-48), said reproduction device comprising:

an encryption decoder adapted to decrypt reproduction stream data output from the recording medium to judge whether the reproduction stream data is encrypted data (See column 8, lines 1-5; (column 8, lines 65-67 to column 9, lines 1-2); Fig. 3);

a first copy control detector adapted to detect the first copy control information from the decrypted reproduction stream data (See column 9, lines 7-10; Fig. 3, block #28);

a contents decoder adapted to extract the digital contents data from the decrypted reproduction stream data (See column 9, lines 18-21; Fig. 3, block #25);

a second copy control detector adapted to detect the second copy control information from the extracted digital contents data (See column 9, lines 7-10; Fig. 3, block #27),

an analog output control portion adapted to generate analog contents data from the extracted digital contents data (See column 5, lines 25-29; Fig. 3, block #26);

and a digital output control portion adapted to convert the extracted digital contents data to a specified output format data to be generated therefrom, wherein, in the case where said reproduction device and said recording device are digital-connected via said digital output control portion, the digital contents data reproduced from said reproduction device includes both the first and second copy control information (See column 9, lines 13-26), (column 10, lines 26- 29, Table on column 11),

and in the case where said reproduction device and said recording device are analog-connected via said analog output control portion, the analog contents data reproduced from said reproduction device includes only the second copy control information (See column 5, lines 25-29; Fig. 3, block #26), (column 10, lines 26- 29, Table on column 11 "Input state, Analog Input").

Regarding claim 13, Matsumoto et al. discloses a digital data recording medium adapted for multimedia copy control (See column 2, lines 28-29), said recording medium comprising:

at least one contents data storage region storing digital contents data which includes first copy control information of a digital format (See column 2, lines 42-44)

and second copy control information of an analog embedded format (See column 2, lines 46-48),

said storage first and second copy control information being allocated in pair for each digital contents unit (See Abstract, column 7, lines 7-16, (column 7, line 67 to column 8 lines 1-5),

wherein the digital contents data stored in the recording medium is adapted to be reproduced from the digital data recording medium so that the reproduced data is decrypted for use in judging whether the reproduction output data is encrypted data (See column 8, lines 1-5; (column 8, lines 65-67 to column 9, lines 1-2); Fig. 3),

the decrypted reproduction data being adapted for use in detecting the first copy control information (See column 2, lines 52-56; column 9, lines 7-10),

and extracting the digital contents data therefrom (See Abstract, column 7, line 67 to column 8 lines 1-5), (See column 9, lines 13-26),

and the extracted digital contents data being adapted for use in detecting the second copy control information (See column 2, lines 52-56; column 9, lines 7-10),

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2,6,12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matsumoto et al. U.S. Patent No. 6,320,829. Matsumoto et al. discloses all the limitations based on claims 1,5,7,11 and 13 as outlined above.

Matsumoto et al. discloses wherein the first copy control information includes three-copy control states of copy free, copy permission with restriction and copy inhibition (See column 4, lines 7-12; Table on column 11),

and in the case where the copy control state of the first copy control information is the copy free state, the reproduction is controlled to be inhibited (See Table on column 11, "none"),

and in the case of the copy permission with restriction and copy inhibition states, the reproduction is controlled to be permissive (See Table on column 11, "none"),

and in the case where the copy control state of the second copy control information is the copy free state, the reproduction is controlled to be permissive (See Table n column 11, "none"),

and in the case of the copy inhibition states, the reproduction is controlled to be inhibited (See Table on column 11).

Matsumoto et al. discloses wherein the second copy control information includes two copy states of copy free and copy inhibition (See column 4, lines 12-16), but does not expressly disclose wherein the second copy control information includes three copy states and in the case of the copy permission with restriction the reproduction is controlled to be inhibited.

But Matsumoto et al. discloses the desirability of having a third state in which reproduction is controlled to be inhibited (See Table on column 11, ("11", "00" and "none").

Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to include a third state and in which reproduction is controlled to be inhibited, as suggested by Matsumoto et al.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents are cited to further show the state of the art with respect to copy control.

- a) U.S. Pat. No. 6,370,319 to Matsumoto et al., which discloses a digital recording apparatus and method.
- b) US Paten Application Publication No. 20020156742 A1 to Ogino et al., which discloses a technique, which can prevent illegal copying.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jorge L Ortiz-Criado whose telephone number is (703) 305-8323. The examiner can normally be reached on Mon.-Thu. (8:30 am - 6:00 pm), Alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, HOF SASS R JEFFERY can be reached on (703) 305-4717. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-6743 for regular communications and (703) 308-6743 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

joc  
January 27, 2003

  
Richemond Dorvil  
Primary Examiner